

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of 7/28/2005.

Reconsideration of the Application is requested.

The Office Action

Claims 1-26 and 28-30 remain in this application.

Claims 1-30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Marlin, et al. (U.S. Patent No. 5,778,377).

Claims 28-30 stand rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement.

Telephone Interview

On April 4, 2006, the applicant conducted a telephone interview with Examiner Wassum. The present amendments to the claims were discussed. The Applicant and the Examiner agreed that the amendments appear to define over Marlin. The Examiner expressed the desire to review the Marlin reference before making a final decision.

The Claims Distinguish over the References of Record

Claim 1 now calls for directing finishing operations based on the populated virtual finishing job ticket database without operator intervention. Marlin does not teach this claimed limitation. As the Examiner points out, in col. 11, lines 45-50, mail jobs can be rescheduled for another line if one line breaks down. Marlin does not, however teach automated rescheduling. The manager applications of Marlin merely flesh out a report that is provided to a user or a mail room owner. (col. 14, lines 27-34) This report can be used by different people for different things, but it would be a user that orders the re-routing of a job in response to the report that says one of the lines is down. Marlin is directed to accommodating the user by allowing them to format the information in a fashion that is most useful to that particular user; (col. 15, lines 1-6) but in Marlin, the user has to ultimately program the print path. In the present application, in contrast, re-programming print/finishing paths can be automated, that is, they can happen without user intervention. Support may be found for this limitation, for example, in the Applicant's non-provisional

application, page 22, lines 3-17.

Because Marlin fails to teach control without operator intervention, it is respectfully submitted that **claim 1** and **claims 2-26** dependent therefrom now distinguish patentably and unobviously over the references of record.

Claim 28 calls for a database that includes control data for automated instruction of the at least one finishing device. As noted above with regard to claim 1, Marlin fails to teach automated instruction of the finishing device.

The Applicant would like to point out, however, that claim 28 did not always call for automated instruction of the finishing device. In the communication from the Applicant dated March 4, 2004, element b) of claim 28 read "control data for instructing performance of at least one finishing device." In the next communication from the Applicant dated June 21, 2004 element b) of claim 28 read "control data for automated instruction of at least one finishing device." Claim 28 is marked as "Original" in both communications, and the added language was not underlined nor the removed language struck out. The representative for the applicant did at that time, however, indicate that the claim was being amended to include the aspect of automation. (page 10, second full paragraph) Moreover, the Examiner acknowledged the amendment by rejecting the amended language, not the original language, at page 6, paragraph 15(b) of the office action mailed 7/28/2005. The same language/rationale of Marlin is used for the instant rejection of claim 28, which is addressed presently.

The Examiner points out that the process object of Marlin contains the steps that a mail piece must go through to be created. This is different from instruction of the finishing devices. The process object of Marlin may contain what needs to be done, (i.e. a certain mail piece needs to be stapled, folded, and inserted into an envelope) but it does not describe what finishers will be doing the stapling, folding, and inserting. The present application contemplates that this will be decided by the system, and not by an operator, thereby automating the entire process. Marlin supplies information about potential problems, but it still requires the user to select the particular devices to which the job will be routed.

Additionally, claim 28 has been amended to alleviate the rejection under 35 U.S.C. § 112. the word "job" was removed, now part c) of claim 28 correctly references the control data of part b) of claim 28. It is therefore respectfully submitted, **claim 28** and

claims 29-30 dependent therefrom distinguish patentably and unobviously over the references of record.

CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-26 and 28-30) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment D. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

Again, in the event the Examiner considers personal contact advantageous to the disposition of this case, should there be issues that can be settled over the phone, he is encouraged to call Pat Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

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4/4/06
Date

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